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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,453	03/12/2004	Donald L. Van Creveld	2003P18809US	7707
7590 Siemens Corporation Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830			EXAMINER KISH, JAMES M	
			ART UNIT	PAPER NUMBER
			3737	
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			03/31/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/799,453

**Applicant(s)**

VAN CREVELD ET AL.

**Examiner**

JAMES KISH

**Art Unit**

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-6 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

Applicant's arguments filed December 23, 2008 have been fully considered but they are not persuasive.

The Applicant argues that "Brock-Fisher does not authorize as a function of the identifier distinguishing the transducer from other transducers of the same type and manufacturer (top of page 6 of Remarks)" because "Brock-Fisher desires to adapt one type of transducer by a first manufacturer to allow use with an imaging system from another manufacturer (bottom of page 5 of Remarks)." The Examiner respectfully disagrees with this conclusion. Column 4, lines 31-37 of Brock-Fisher clearly states, "The identification information identifies the type of transducer connected to the ultrasound imaging device. The identification information accommodates connecting different types of transducers of a manufacturer with the same manufacturer's ultrasound imaging device, allowing for interchangeability of the manufacturer's probes." In response to the Applicant's argument that Brock-Fisher includes additional structure not required by the Applicant's invention (that being that transducers from a different manufacturer may be used with another manufacturer's imaging system), it must be noted that Brock-Fisher discloses the invention as claimed. That fact that it discloses additional structure (or functionality) not claimed is irrelevant.

Regarding the lack of positively claiming the particular imaging device, it is recommended that the Applicant positively claim that the system comprise "a transducer; and a particular imaging device" within the body of claim 1. A preamble is

generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The wherein clauses disclose functional language and therefore are not granted patentable weight within an apparatus claim. Section 2114 of the MPEP states (with emphasis in the original), "Apparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). "Section 2113 of the MPEP states, "A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). "Section 2114 of the MPEP states, "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)."

For at least the reasons above, the rejection of the claims as defined in the Office Action dated December 23, 2008 still stands and is repeated below.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a positive link defining what structure within the body of the claim is actually part of the transducer and/or the particular imaging system. For example, the preamble (which is generally not granted patentable weight unless specifically called upon by the body of the claims) states that there is a transducer and a particular imaging system. The body of claim 1 positively cites "an electronic identifier associated with the transducer; and a processor operable to generate a security signal in response to the electronic identifier." The electronic identifier is not positively claimed as a tangible structure until claim 3 when it is defined as a memory. The term "associated" is abstract in that a person may be associated with an organization. There is no physical link, but only an abstract idea that the person is "part of" that organization. According to claim 1, the processor is not structurally connected to either one of the transducer or the particular imaging system. Therefore, it is unclear what is being claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brock-Fisher (US Patent No. 6,500,126). Brock-Fisher discloses an ultrasound imaging system comprising an ultrasound transducer, an ultrasound imaging device wherein there is provided an interface to allow compatible electrical information signals to/from the ultrasound transducer from/to the ultrasound imaging device via connectors (see Abstract). The identification information identifies the type of transducer connected to the ultrasound imaging device. The identification information accommodates connecting different type transducers of a manufacturer with the same manufacturer's ultrasound imaging device. However, a transducer from one manufacturer cannot

operate with an ultrasound device from other manufacturers, unless the manufacturers cooperate by disclosing/sharing interface information (column 1, line 45 through column 2, line 11). The identification information is stored in a memory unit (column 4, lines 28-37). Column 8, line 66 through column 9, line 4 describes a database, which would inherently have to be stored in a memory, of configurations to operate various transducers with incompatible electrical information signals, the database automatically loaded by the adapter (i.e., the connector). This corresponds to claims 5 and 10. It would be obvious to one of skill in the art that if no entry is found in the database for a particular transducer that is attached, that an error signal, which could also be termed a security signal, would be output as feedback in order to notify the user that the system is inoperable with such an arrangement. Regarding claim 6, column 9, lines 7-9 states, the database can be updated using conventional techniques, such as from the adapter or via an external system in communication with the ultrasound imaging device.

The Examiner notes that the information stored within the memory does not change the structure of the device, nor do the signals being transmitted to/from the memory.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES KISH whose telephone number is (571)272-5554. The examiner can normally be reached on 8:30 - 5:00 ~ Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRIAN CASLER/



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JMK